

**REMARKS**

Claims 11-20, 22, 23, 25-28, 30-32, and 44-52 were previously pending in this application. Although the Office listed claim 42 as pending, Applicants respectfully note that this claim was canceled in the Amendment of June 16, 2003.

With this Amendment, claims 1-52 have been canceled.

**Claim objections**

The Office objected to the claims because some of them depended on later numbered claims. Applicants have reordered and renumbered the pending claims as new claims 53-78. These new claims are supported by the original claims and do not add new matter. For the convenience of Office, the following table shows the correspondence between the previous and new claims:

Previous claim	New claim
11	54
12	55
13	56
14	58
15	59
16	60
17	61
18	62
19	63
20	64
22	66

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

23	67
25	68
26	--
27	69
28	70
30	72
31	73
32	74
44	53
45	65
46	71
47	75
48	77
49	57
50	76
51	78
52	79

Applicants respectfully request that the objection be withdrawn.

35 U.S.C. § 112

The Office rejected claims 25, 26, and 45 under 35 U.S.C. § 112, first paragraph, for lack of enablement because it was asserted that there is no purpose for delivering a therapeutic protein to a cell *in vitro*. See Office Action of August 28, 2003, item 6.

Claims 25, 25, and 45 have been cancelled. Applicants' new claims do not require a "therapeutic protein." Therefore, Applicants respectfully request that this rejection be withdrawn.

The Office rejected claims 48 and 50-52 under 35 U.S.C. § 112, first paragraph, because it asserted that claimed subject matter was not described in the specification. See Office Action of August 28, 2003, items 7-9. Specifically, the Office asserted that the language "wherein any other sequences of *pol* is absent" is not described. As the Office suggested, Applicants have included the term "wherein any other sequence of *pol*, other than the 178 bp fragment comprising the cPPT and CTS sequence, is absent" in new claims 76, 78, and 79, which correspond to previous claims 50-52. Applicants acknowledge the Examiner's helpful suggestion and respectfully request that the rejection be withdrawn.

35 U.S.C. § 102

The Office rejected claims 11, 12, 14-20, 22, 23, 25, 27, 28, 30-32, and 44-47 under 35 U.S.C. § 102(b) as being anticipated by Zufferey et al. See Office Action of August 28, 2003, item 11. Applicants respectfully traverse this rejection because Zufferey et al. does not disclose a nucleic acid that comprises "at least one cPPT and CTS sequence, wherein any other sequence of *pol*, other than the 178 bp fragment comprising the cPPT and CTS sequence, is absent." In fact, Zufferey et al. do not discuss the cPPT or CTS sequences at all, and therefore do not inherently disclose a nucleic acid that has "at least one cPPT and CTS sequence, wherein any other sequence of *pol*, other than the 178 bp fragment comprising the cPPT and CTS sequence, is absent." Because each of the new dependent claims, claims 53, 65, 71,

76, 78, and 79 include this element, they are not anticipated by Zufferey et al. See *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Applicants respectfully request that this rejection be withdrawn.

Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 25, 2003

By: 

Deborah Katz

Reg. No. 51,863

Phone: (202) 408-4382

Fax: (202) 408-4400

E-mail: [deborah.katz@finnegan.com](mailto:deborah.katz@finnegan.com)

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)